

REMARKS

A. The Status of the Claims and the Amendments

By the present amendment, claims 3, 4, 11, 15, 17, 61, 63, and 64 have been amended to more particularly define the Applicants' invention and to claim it with greater specificity. Claims 54 and 60 have been canceled without prejudice. New claims 66 and 67 have been added. New claim 66 represents claim 54 re-written in independent form. New claim 67 corresponds to the canceled claim 60. The amendments to claims and the subject matter claimed in new claims are supported by the specification and the original claims. No new matter have been added.

After the present amendment has been entered, claims 3, 4, 6-17, 22-35, 61, and 63-67 will be pending, of which claims 12 and 13 have been previously withdrawn from consideration. It is submitted that the amendments place the claims in condition for allowance. Entry of the amendments is respectfully requested.

B. Rejection Under 35 U.S.C. § 103(a)

Claims 3, 4, 6-11, 14, 17, 22-35, 61 and 63-65 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the published PCT patent application WO 96/40285 (Unger et al.) (item 5, pages 3-7 of the Office Action). This rejection is respectfully traversed on the following grounds.

It is a well established rule that a claim of a pending application filed on or after November 29, 1999 cannot be rejected on the obviousness grounds over a 35 U.S.C. § 102(e) reference if, at the time of the invention claimed in the pending application, the subject matter and the claimed invention in the pending application and the reference were commonly owned. See, 35 U.S.C. § 103 (c).

To invoke 35 U.S.C. § 103 (c), it must be shown that: (1) the application in question was filed on or after November 29, 1999; (2) the reference qualifies under 35 U.S.C. § 102(e); (3) the reference is only usable for the obviousness rejection but not for the anticipation rejection; (4) the subject matter claimed in the application in question and in the reference were commonly owned or were subject to an obligation to assign that would establish common ownership. See, MPEP § 706.02(l). It is submitted that all four of these requirements have been satisfied.

The present application was filed on October 30, 2000, which is after November 29, 1999. Unger et al. qualifies under 35 U.S.C. § 102(e) as a PCT application. See, MPEP § 706.02(f)(1). Unger et al. does not qualify as an anticipatory reference because it fails to disclose every element of claim 17; specifically, as conceded by the Examiner (page 6 of the Office Action, at the bottom of the page), Unger et al. fail to teach the use of compounds with targeted vesicles comprising phosphatidylcholine.

Finally, at the time the claimed invention was made (i.e., not later than the filing date of the present application, October 30, 2000), the subject matter claimed in Unger et al. and the subject matter claimed in the present application were commonly owned by IMARx Corp. ("IMARx"), and are now still owned by IMARx. Indeed, the subject matter claimed in Unger et al. was owned by IMARx not later than May 1, 1996, as can be seen from the title page of WO 96/40285 which identifies IMARx as the applicant. The present application was also owned by IMARx at the time the claimed invention was made, which is evidenced by assignment made by the inventors in favor of IMARx on February 5, 2001, recorded on Reel 011504, Frames 0693-0696.

In view of the foregoing analysis, it is submitted that under 35 U.S.C. § 103(c) Unger et al. may not be used as a reference against the present application for purposes of a rejection under §103(a). Therefore, it is submitted that the §103(a) rejection is improperly taken and should be withdrawn.

Accordingly, claim 17 is patentably distinguishable over Unger et al. Each of claims 3, 4, 6-11, 14, 22-35, 61, and 63-65 directly or indirectly depends on claim 17, and is patentably allowable for at least the same reason. Reconsideration and withdrawal of the rejection of claims under 35 U.S.C. §103(a) are, therefore, respectfully requested.

C. Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 6-11, 14, 17, 22-35, 61, and 63-65 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter regarded as the invention (item 6 on page 7 of the Office Action). Specifically, the Examiner objected to using the word “about” to define the number of carbons in functional groups.

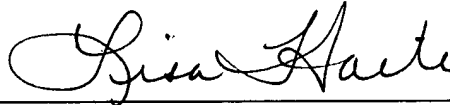
The word “about” has been deleted from the claims. Accordingly, it is submitted that the 35 U.S.C. § 112, second paragraph, rejection does not apply. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved, the Examiner is requested to contact the undersigned at the telephone number given below so that a prompt disposition of this application can be achieved.

No fee is deemed to be due in connection with this response. However, if any fee is due, the Commissioner is hereby authorized to charge any other fees associated with the filing submitted herewith, or credit any overpayments to Deposit Account No. 07-1896.

Respectfully submitted,



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